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REMARKS

Reconsideration of the application is requested.

In the Office Action dated August 5, 2005, claims 1-9 were not rejected over the prior art, and are therefore believed to be allowable.

In the Office Action dated August 5, 2005, claims 10, 15 and 16 were rejected under 35 U.S.C. §102(b) as being anticipated by Gefroh '587 and '640. Claims 11-14 and 17-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Gefroh '587 or '640 in view of Kemp '828.

Also, the Office Action stated that "The indicated allowability of claims 10-20 is withdrawn in view of the *newly discovered* reference(s) to Gefroh et al (5107640) and Gefroh (5657587)." (Emphasis added.) However, Applicant filed an Information Disclosure Statement listing Gefroh 5,657,587 and Gefroh 5,107,640, and this Information Disclosure Statement was signed by Examiner Chapman and dated October 25, 2004. Thus, the Examiner previously indicated that claims 10-20 were, in fact, allowable over Gefroh '640 and Gefroh '587.

The directly contradictory positions taken by the Examiner in the present application raise questions concerning the appropriateness of the rejection of claims 10-20. MPEP 706 states that "The goal of examination is to clearly articulate any rejection early in the prosecution process so that the Applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity." (Emphasis added.) Clearly, this goal is not being achieved in the present application. Further, 37 C.F.R. §1.104(c)(2) states "In rejecting claims for want of novelty or for obviousness, the Examiner must cite the best references at his or her command." (Emphasis added.) Clearly, Gefroh '640 and '587 were at the Examiner's command, such that one or both of the Office Actions do not comply with 37 C.F.R. §1.104.

Still further, MPEP 706.04 states that "A claim noted as allowable shall thereafter be rejected only after the proposed rejection has been submitted to the primary Examiner for consideration of all the facts and approval of the proposed action. Great care should be exercised in authorizing such a rejection." See *Ex parte Grier*, 1923 C.D. 27, 309 O.G. 223

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(Comm'r Pat. 1923); *Ex parte Hay*, 1909 C.D. 18, 139 O.G. 197 (Comm'r Pat. 1909)
(Emphasis added.).

In view of the above, Applicant respectfully requests examination of the present application according to the applicable rules and procedures.

Claim 10 recites a vertical wall member having a central portion horizontally spaced from first and second end portions to define a central space bounded by the end portions and the central portion. In contrast, the step faces 12 of Gefroh '587 are flat, and in no way define a central space bounded by end portions and a central portion as recited in claim 10.

Furthermore, claim 10 has been amended to recite that the connector structure is configured to simultaneously secure the first and second end portions of the wall member to a foundation of a building with the central portion spaced apart from such a foundation. Clearly, the step faces 12 of Gefroh '587 do not include any such arrangement. Furthermore, the areaway system shown in Fig. 10 of Gefroh '640 also does not disclose or suggest such an arrangement.

Claims 11-20 depend from claim 10, and are therefore believed to be allowable for those reasons set forth above in connection with claim 10.

Applicant has also added claims 39-56. New claims 39-56 correspond to canceled claims 21-38. In the prior Office Action dated May 17, 2005, claims 21-23, 26 and 27 were rejected under 37 U.S.C. §103(a) as being unpatentable over Kemp '828 in view of Bradley '206. Claims 28-31 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kemp '828 in view of Bradley '206 and further in view of Poole '455. Claims 32-38 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kemp '828 in view of Bradley '206 and further in view of Gavin '451. Claims 24 and 25 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kemp '828 in view of Bradley '206 and further in view of Poole '455.

As the Examiner may be aware, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make

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the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. MPEP 2143; *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicant has reviewed Kemp '828 and Bradley '206, and finds no teaching or suggestion whatsoever to modify the steel metal window well of Kemp '828 to include the extruded plastic connectors 30 and 31 of Bradley '206. Furthermore, even if one attempted to modify Kemp '828 to include the extruded plastic connectors 30 and 31 of Bradley '206, it is not at all clear how this could be accomplished without interfering with the snap together arrangement taught by Kemp '828. Clearly, the references themselves do not in any way teach or suggest the substantial modifications that would be required to attempt such an arrangement. It is also very unclear how the connectors 30 and 31 of Bradley '206 could be modified for use with Kemp '828 without interfering with attachment flanges 14 of Kemp '828. Applicant reiterates that the burden of establishing a prima facie case of obviousness falls on the Examiner; Applicant does not need to show that such modification is impossible, although it may well be in the present case. Applicant further requests that the Examiner point out where the references teach or suggest the claimed combination and the reasonable expectation of success as required by MPEP 2143.

Claims 40-43 (prior 22-25) depend from claim 39 (prior 21), and are therefore believed to be allowable for those reasons set forth above in connection with claim 21.

With respect to independent claim 44 (prior 26), neither Bradley '206 nor Kemp '828 in any way provide the required suggestion or motivation for establishing a prima facie case of obviousness. The Office Action of May 17, 2005 states that "One of ordinary skill in the art would have placed the mating connectors and tapered portions at any location needing a connection point. It would have been obvious to one of ordinary skill in the art to modify the end portions to include tapered ends with mating wedge/openings in order to seamlessly mate with the vertical member above or below." Applicant is quite unsure how the "seamlessly mate" motivation proposed by the Examiner is found in the cited referenced references. To the extent Applicant understands the Examiner's position, Kemp '828 already "seamlessly mates", such that there would be no reason whatsoever to provide such a hypothetical arrangement

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based on Bradley '206. Furthermore, the Office Action also states "The stop structures are configured to engage another identically nested web member in order to neatly stack members minimizing the appearance of seams." This assertion is completely unsupported by the cited references. Furthermore, the hypothetical "minimizing the appearance of seams" motivation is entirely irrelevant to the stop structures recited in claim 44. Applicant respectfully requests that the Examiner point out how the connectors 30 and 31 of Bradley '206 could possibly be stop structures as recited in claim 44 (prior 26), even if combined with Kemp '828 in the speculative manner proposed by the Examiner.

Claim 45 (prior 27) depends from claim 44, and is therefore believed to be allowable for those reasons set forth above in connection with claim 44.

With respect to independent claim 46 (prior 28), Applicant has reviewed Poole '455, and can find no teaching or suggestion of a web extending transversely towards a central space defined by an upright wall and extending between and interconnecting upper and lower webs to reinforce a step formed by the webs. The bolt-in steps 12 of Poole '455 form step cavities 26 in the outside surface of the structure. Column 4, lines 48-54. Accordingly, Poole '455 fails to disclose a web as recited in claim 46, such that claim 46 cannot possibly be anticipated by the cited references, even if combined in the hypothetical manner proposed by the Examiner.

Claims 47-50 (prior 29-32) depend from claim 46, and are therefore believed to be allowable for those reasons set forth above in connection with claim 46.

Independent claim 51 (prior 33) recites first and second upright wall members with overlapping portions. The overlapping portion of the first wall member includes a boss having a cavity facing an upright portion of the second wall member, such that a fastener can be extended generally horizontally through the second wall member and into the boss to interconnect the first and second wall members.

As an initial matter, it is quite unreasonable to construe Bradley '206 as disclosing a boss having a cavity facing an upright portion of a second wall member as recited in claim 51. Applicant appreciates the fact that claim terms are construed broadly during the examination process. However, specific features of the prior art cannot be contorted and twisted in an

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absurd manner that is contrary to the manner in which the prior art would be viewed by one skilled in the art.

Furthermore, Applicant notes that "It is impermissible within the framework of §103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." *In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965); see also *In re Mercer*, 515 F.2d 1161, 1165-66, 185 USPQ 774, 778 (CCPA 1975). Clearly, the Kemp '828, Bradley '206 and Gavin '451 references themselves do not teach or suggest the extensive modifications that would be required.

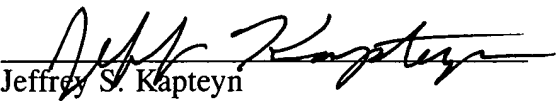
Claims 52-56 (prior 34-38) depend from claim 51, and are therefore believed to be allowable for those reasons set forth above in connection with claim 51.

Applicant has made a concerted effort to the place the present application in condition for allowance, and a notice to this effect is earnestly solicited. In the event there are any remaining informalities, the courtesy of a telephone call to the undersigned attorney would be appreciated.

Respectfully submitted,

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Date



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